United States Court of Appeals for the Federal Circuit

93-1088

HILTON DAVIS CHEMICAL CO.,

Plaintiff-Appellee,

v.

WARNER-JENKINSON COMPANY, INC.,

Defendant-Appellant.

O R D E R

The appeal, having been heard by a panel of the court and, thereafter, a majority of circuit judges in regular active service having acted sua sponte in accordance with 28 U.S.C. §46(c) and Fed. R. App. P. 35(a),

IT IS ORDERED that the appeal shall be decided in banc.

IT IS FURTHER ORDERED that the parties shall file supplemental briefs on the following schedule:

The brief for appellant on rehearing in banc shall be filed on or before January 7, 1994. The brief for appellee on rehearing in banc shall be filed on or before February 4, 1994.

The following questions only shall be addressed in the briefs:

(1) Does a finding of patent infringement under the doctrine of equivalents require anything in addition to proof of the facts that there are the same or substantially the same (a) function, (b) way, and (c) result, the so-called triple identity test of Graver Tank v. Linde Air Products Co., 339 U.S. 605, 85 USPQ 328 (1950), and cases relied on therein? If yes, what?

(2) Is application of the doctrine of equivalents by the trial court to find infringement of the patentee's right to exclude, when there is no literal infringement of a claim, discretionary in accordance with the circumstances of the case?

(3) Is the issue of infringement under the doctrine of equivalents an equitable remedy to be decided by the court, or is it, like literal infringement, an issue of fact to be submitted to the jury in a jury case?

Amicus curiae briefs on rehearing in banc may be filed in accordance with Rule 29.

Oral argument will be scheduled after the briefs have been filed.

FOR THE COURT

Francis X. Gindhart

12/3/93

Francis X. Gindhart
Clerk

cc: J. Robert Chambers, Esq.
David E. Schmit, Esq.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
DEC 3 1993
FRANCIS X. GINDHART
CLERK

APPENDIX B

MOTION OF DEFENDANTS/APPELLANTS TO RECALL THE MANDATE, OPEN JUDGMENT AND PERMIT DEFENDANTS/APPELLANTS TO FILE A BRIEF ON, AND ARGUE THE ISSUES RAISED IN, THIS COURT'S SUA SPONTE ORDER IN *HILTON DAVIS CHEMICAL CO. v. WARNER-JENKINSON COMPANY, INC.*, CAFC, NO. 93-1088

IN THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

92-1358,-1387

MILES LABORATORIES, INC. and TRIANGLE BIOMEDICAL EQUIPMENT, INC.,

Plaintiffs/Cross-Appellants,

v.

SHANDON INC. AND SHANDON SOUTHERN PRODUCTS LIMITED,

Defendants/Appellants.

On appeal from a decision of the United States District Court for the Western District of Pennsylvania in 86-2404 entered May 8, 1992, from Judge Gustave Diamond.

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Attorneys for Defendants/
Appellants, Shandon Inc.
and Shandon Southern
Products Limited

December 20, 1993

MOTION OF DEFENDANTS/APPELLANTS TO RECALL THE MANDATE, OPEN JUDGMENT AND PERMIT DEFENDANTS/APPELLANTS TO FILE A BRIEF ON, AND ARGUE THE ISSUES RAISED IN, THIS COURT'S SUA SPONTE ORDER IN *HILTON DAVIS CHEMICAL CO. v. WARNER-JENKINSON COMPANY, INC.*, CAFC, NO. 93-1088

Defendants/Appellants, Shandon Inc. and Shandon Southern Products Limited ("Shandon"), move this Court to recall the mandate and open the Judgment rendered June 14, 1993 in the above-captioned appeals to permit rehearing on the question of infringement under the doctrine of equivalents for the reasons set forth hereinbelow.

On June 14, 1993, a three judge panel of this Court decided that Shandon's tissue processor, the Hypercenter, did not literally infringe the claims of U.S. Patent No. Re. 29,073 but that the Hypercenter did infringe the claims of the '073 patent under the doctrine of equivalents.[1] Thereafter, on November 24, 1993, Shandon filed a Petition for Writ of Certiorari which requests the U.S. Supreme Court to review the following question:

> To best serve the Constitutional purpose of promoting the Progress of Science and the useful Arts, should the reach of the Doctrine of Equivalents be determined only by the *subjective* and increasingly inconsistent application of the function/way/result test, or by an evaluation of the four *objective*

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[1] A copy of this Court's opinion is attached as Appendix A.

> factors advanced by [the Supreme Court] in *Graver Tank* as justification for a finding of infringement under the Doctrine?

A copy of Shandon's Petition For Writ Of Certiorari is attached hereto as Appendix B ("Shandon's Petition"). In Shandon's Petition, Shandon argues that the Federal Circuit has rotely applied the function/way/result test as the sole criterion for finding infringement under the doctrine of equivalents and thus has disregarded the other three objective benchmarks advanced by *Graver Tank*[2] to justify the application of the doctrine.

On December 3, 1993, this Court issued *sua sponte* an order that the appeal in *Hilton Davis Chemical Co. v. Warner-Jenkinson Company, Inc.*, CAFC, No. 93-1088, (the "*Hilton Davis* Order") be decided in banc and that the parties thereto file supplemental briefs on *inter alia* the following question:

> (1) Does a finding of patent infringement under the doctrine of equivalents require anything in addition to proof of the facts that there are the same or substantially the same (a) function, (b) way, and (c) result, the so-called triple identity test of *Graver Tank v. Linde Air Products Co.*, 339 U.S. 605, 85 USPQ 328 (1950), and cases relied on therein? If yes, what?

A copy of the *Hilton Davis* Order is attached hereto as Appendix C.

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2 339 U.S. 605, 608-12 (1950)

The issues raised by the first question in the *Hilton Davis* Order are virtually the same as the issues raised by Shandon's Petition. This Court's resolution of those important issues could make their consideration by the Supreme Court unnecessary and thereby cause the denial of Shandon's Petition. Shandon, therefore, would lose its opportunity to be heard on these issues.[3]

The law regarding the application of the doctrine of equivalents undoubtedly will be clarified, perhaps even dramatically altered, by this Court's in banc decision in the *Hilton Davis* appeal. Because the appeal proceedings on the liability phase of this case are still open, it is only fair and just that this Court's impendent ruling on the application of the doctrine of equivalents be applied to the instant case. Otherwise, with a (not unexpected) denial of Shandon's Petition by the Supreme Court, this case returns to the district court for an accounting for damages -- a truly unjust result. Accordingly, Shandon moves this Court:

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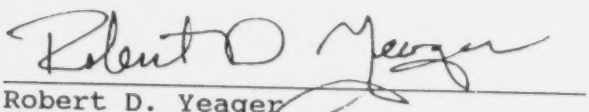
[3] Shandon did not raise the issue before this Court in its appeal brief because the district court's single sentence conclusion under the doctrine of equivalents was virtually devoid of analysis. [Appendix B, A-38-39]. Accordingly, Shandon invited this Court to remand the question or reverse. Instead, this Court performed its own equivalents analysis (flawed, in our submission) and that action prompted Shandon's Petition.

- to recall the mandate of July 6, 1993 to restore this Court's jurisdiction;
- to open the Judgment in the above-captioned appeals to permit rehearing on the issue of infringement under the doctrine of equivalents;
- to consolidate these appeals with this Court's consideration of *Hilton Davis Chemical Co. v. Warner-Jenkinson Company, Inc.*, CAFC, No. 93-1088;
- to permit the parties to these appeals to file briefs and argue the questions raised *sua sponte* by this Court in the *Hilton Davis* Order, at least to the extent that those questions apply to the record in this case; and
- to apply the principles of this Court's in banc decision in the *Hilton Davis* appeal to these appeals.

Shandon is filing with the U.S. Supreme Court a MOTION TO STAY CONSIDERATION OF PETITION FOR WRIT OF CERTIORARI PENDING CLARIFICATION OF THE FEDERAL CIRCUIT'S IMPENDING TREATMENT OF THE QUESTION RAISED IN THE PETITION. If this Court grants the within motion, Shandon's Petition will be withdrawn.

The undersigned counsel has discussed the instant Motion with counsel for the Plaintiff/Cross-Appellants, Miles Laboratories, Inc. and Triangle Biomedical Equipment, Inc. ("Miles"), and has been informed that Miles objects to the instant Motion and intends to file a response to the instant Motion.

Respectfully submitted,



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Attorneys for Defendants/
Appellants, Shandon Inc.
and Shandon Southern
Products Limited

Dated: December 20, 1993

CERTIFICATE OF INTEREST

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

MILES LAB INC v. SHANDON INC
No. 92-1358, -1387

Counsel for the appellant certifies the following:

1. The full name of every party or amicus represented by me is:

   Shandon Inc.
   Shandon Southern Products Limited (now by change of name Life Sciences International (Europe) Ltd.)

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

   ---

3. The parent companies, subsidiaries (except wholly-owned subsidiaries), and affiliates that have issued shares to the public, of the party or amicus curiae represented by me are:

   Appellants, Shandon Inc. and Shandon Southern Products Limited (now by change of name Life Sciences International (Europe) Ltd.) are direct or indirect subsidiaries of Life Sciences International PLC, a company organized under the laws of the United Kingdom.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

   Kirkpatrick & Lockhart - Robert D. Yeager, Esq.
   Christine R. Ethridge, Esq.

December 20, 1993

Robert D Yeager

Counsel for Defendants/Appellants

CERTIFICATE OF SERVICE

I certify that I am counsel for Petitioners, Shandon Inc. and Shandon Southern Products Limited, and that two copies of the foregoing MOTION TO STAY CONSIDERATION OF PETITION FOR WRIT OF CERTIORARI PENDING CLARIFICATION OF THE FEDERAL CIRCUIT'S IMPENDING TREATMENT OF THE QUESTION RAISED IN THE PETITION were served on Respondents by first class mail, postage prepaid, to the following:

Arnold Sprung, Esq.
Nathaniel D. Kramer, Esq.
Sprung, Horn, Kramer & Woods
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Lynn J. Alstadt, Esq.
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Pittsburgh, PA 15219

this 20th day of December, 1993.

Robert D. Yeager